

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-76 are presently active in this case, Claims 1, 13, 25, 37, 42, and 47 having been amended and Claims 53-76 has been added by way of the present Amendment.

In the outstanding Official Action, Claim 52 was restricted "because it adds a new limitation that would necessitate a new search." The Applicants respectfully submit that this is an improper rationale for making a restriction. MPEP 803 sets forth proper criteria for restriction, however no such analysis was presented in the Official Action. Thus, the Applicants respectfully traverse the restriction requirement based on MPEP § 803, which states:

... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, the Applicants respectfully traverse the outstanding restriction requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Claims 1, 13, 25, 37, 42, and 47 were rejected under 35 U.S.C. 102(e) as being anticipated by Becker et al. (U.S. Patent No. 6,658,452 B1). Claims 2-8, 11, 12, 14-20, 23, 24, 26-32, 35, and 36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. in view of Britton (U.S. Patent No. 6,591,289 B1). Claims 9, 10, 21, 22, 33, and

34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al. in view of Britton and further in view of Smith (U.S. Patent No. 6,385655 B1). For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

In the Office Action, the Becker et al. reference is indicated as anticipating each of independent Claims 1, 13, 25, 37, 42, and 47. However, the Applicants note that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Becker et al. reference clearly does not meet each and every limitation of the independent Claims 1, 13, 25, 37, 42, and 47.

The Official Action surmises that the Becker et al. reference describes providing consulting advice to a user by providing a list of available applications to the user, from which the user can choose. The Applicants submit that simply providing a list of available applications does not provide the user with any consulting advice based upon data input by the user. Claims 1 and 37 of the present application recite, among other steps, a step of providing a user with consulting advice regarding a request based upon data input by the user. Claims 13 and 42 of the present application recite, among other features, means for providing a user with consulting advice regarding a request based upon data input by the user. Furthermore, Claims 25 and 47 recite, among other features, a computer code device configured to provide a user with consulting advice regarding a request based upon data input by the user. The specification of the present application discloses numerous non-limiting examples of such consulting advice. (See, e.g., page 2, lines 22-27, and page 6, lines 13-30.)

The Applicants submit that the Becker et al. reference does not teach or suggest the above limitations.

The Official Action focuses on the presentation of available applications to the user, when discussing the consulting advice recited in the claims of the present application. However, the Applicants respectfully submit that simply providing the user with a list to select from does not anticipate providing a user with consulting advice based upon data input by the user. By way of analogy, providing someone with an entire yellow page listing is distinctly different than recommending five restaurants to an individual based upon the particular needs of the individual. The present application provides a user with consulting advice based upon data input by the user. To the contrary, the Becker et al. reference merely provides a listing of applications that are available to all users. No consultation is provided to the user regarding a selection. The Becker et al. reference does not disclose or suggest providing any type of consulting advice to the user based upon input from the user.

Since the Becker et al. reference does not disclose all of the limitations recited in independent Claims 1, 13, 25, 37, 42, and 47, then the Applicants submit that these claims are not anticipated by the Becker et al. reference. Accordingly, the Applicants respectfully request the withdrawal of the anticipation rejections of Claims 1, 13, 25, 37, 42, and 47.

Claims 2-12, 14-24, 26-36, 38-41, 43-46, and 48-51 are considered allowable for the reasons advanced for Claims 1, 13, 25, 37, 42, and 47 from which they depend, since the secondary references cited against these claims do not supplement the deficiencies noted above with respect to the Becker et al. reference. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor

Application Serial No.: 09/684,965
Reply to Office Action dated September 2, 2004

suggested by the applied references when those features are considered within the context of

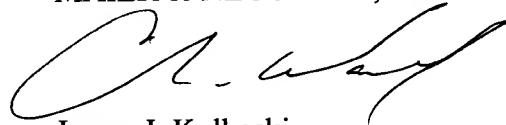
Claims 1, 13, 25, 37, 42, and 47.

Newly added Claims 53-76 is considered allowable as they recite features of the invention that are neither disclosed nor suggested by the references of record. The new claims are allowable for at least the reasons indicated above with respect to the independent claims from which they depend. Support for new Claims 53-76 is present in the present application, for example, on page 6, lines 13-30.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Registration No. 34,648
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

JJK:CDW:brf
I:\atty\cdw\197849US28\am2.doc